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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT

PAPER NUMBER

2653

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/020,980

Applicant(s)

KO ET AL.

Examiner

Aristotelis M Psitos

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*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply****A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 19 December 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-8 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. 09/333,520.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

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**DETAILED ACTION**

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/333520, filed on 6/15/99.

Although applicants' identify the present application as a divisional of Sn 09/333,520 this examiner has been unable at the present time to review the file of that application. Hence this examiner is not certain whether this is a voluntarily filed divisional or one filed in response to a restriction requirement. If this is a voluntarily filed application, applicants' cooperation in reviewing the claims to ensure that there is no conflicting claims necessitating an obvious double patent rejection is respectfully requested.

***Information Disclosure Statement***

The IDS of 12/19/01 is acknowledged; however, none of the foreign documents cited therein have been reviewed. (No copies have been supplied).

***Drawings***

2. Figures 1-3 and 10-13 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the DVD-R version 1.0 & 1.9 as found on page 3 – section (0012), does not reasonably

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provide enablement for any other version, or DVD-RW version. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. There is no other specification defined.

6. Claims 1- 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, in the independent claim, RMA is never defined. ✓

Also, as recited, claim 1 is drawn to a product, a record medium nevertheless, claim 4 attempts to include method limitations drawn to a process. This claim hence not only fails to further define the parent claim – a 35 USC 112 paragraph 4 problem, but also is not understood since a method limitation cannot further define a product. Hence claim 4 fails to satisfy current USPTO practice. NO ART IS DEVELOPED WITH RESPECT TO CLAIM 4 because the examiner is not sure what applicants' would like to protect. ✓

AS FAR AS THE REMAINING CLAIMS ARE UNDERSTOOD AND INTERPRETED BY THE EXAMINER THE FOLLOWING ART REJECTIONS ARE MADE.

***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1,3 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McFerrin et al.

With respect to claim 1 applicants' attention is drawn to column 4, lines 52 – 59; col. 9 line 10 – to column 12 line 27. The examiner interprets the controller management area as discussed in the reference to be the recording management data field of RMA as recited in claim 1. Regarding the above identified segments of the reference, there is an overwrite protection feature disclosed. Therefore the examiner concludes that the wherein phrase limitation in claim 1 is met. With regards to the remaining limitations found in claim 1, the examiner concludes that these are inherently present in the disk of the reference. The examiner considers the lead-in, lead-out areas and the user data area as inherently present.

If applicants' can convince the examiner that these areas are not inherently present in the McFerrin document, then the examiner would rely upon applicants' admitted acknowledged Prior Art that

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discusses such areas in this environment in order to present a rejection under 35 USC 103(c), where the motivation would be to have such acknowledged areas for their inherent use in the McFerrin document.

With respect to claim 3, as discussed in this document this right protection feature is found a plurality of times throughout the disk. Hence the limitation of claim 3 is met.

With respect to claim 8 there is no cartridge disclosed for encompassing the disk of McFerrin.

11. Claims 2, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the McFerrin document as applied to claim 1 above, and further in view of the acknowledged Prior Art.

With regards to claim 2, the examiner interprets the DVD-RW specification to refer to the version 1.0 and version 1.9 as acknowledged as being prior art in applicants' disclosure.

With regards to claim 5, the examiner considers these limitations to refer back to the

✓ acknowledged Prior Art with regards to figure 3.

With regard to claim 6, since the McFerrin document discloses that the information format of his record comprises a plurality of bands, the fields are grouped with the same write protection information as recited.

It would have been obvious to one of ordinary skill in the art to modify the base-reference of McFerrin with the teaching(s) from the acknowledged Prior Art, motivation is to take its vantage of existing disk formats available to those of ordinary skill in the art and therefore save valuable resources in reading inventing limitations that already exist.

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of McFerrin et al.

With regards to the limitations of claim 7, applicants' attention is drawn to the formats identified in figures 6 through 11 of the McFerrin document. As noted therein different bytes in different segments are reserved for special features. Although no specific byte is designated as the write protect indicator, the use of a designated byte for such a function is considered merely a selection of alternative equivalents. That is, the use of a byte and its position for control functions is well known as discussed by McFerrin. The selection of a particular byte for a designated function as opposed to a different function is up to a

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particular user's choice. No unexpected results are seen to occur from the selection of one byte position over another.

13. Claims 1, 3, and 8 are rejected under 35 U.S.C. 102(b)/103 (c) as being anticipated by Curtis et al.

With regards to the independent claim, applicants' attention is drawn to Column 4, lines 40 plus, which disclosed the capability of having a write protection capability. As discussed above with respect to the McFerrin et al document, the remaining limitations of claim 1(that is, lead-in, lead-out, and user data areas) are inherently present in the Curtis et al document as well.

14. Claims 2, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curtis et al as applied to claim 1 above, and further in view of the acknowledged Prior Art.

The reasons stated above in paragraph 11 are repeated here in.

It would have been obvious to one of ordinary skill in the art to modify the base reference of Curtis et al with the teaching(s) from acknowledged Prior Art; motivation is to modify a DVD with the right protection feature of Curtis et al. in order to prevent unwanted overwrites/erasures as well as to take advantage of existing formatting in this environment and hence save valuable resources such as time in order to re-create the acknowledged Prior Art format.

14. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dang et al considered with Sako.

Applicants' attention is drawn to the disclosure in the Dang reference with respect to the write protect feature see for instance figure 3. There is no specific disclosure designating where this write protect code is found in the record medium.

Sako discloses in this environment, the ability of a table of contents area (TOC) that contains a plurality of disk control information and directory information, see col. 6 lines 36 plus. Furthermore this document discloses the ability of a copy protect control signal to be found in the table of contents area. The copy protect/management information signal is designated as CGM.

It would have been obvious to one of ordinary skill in the art to modify the base reference of Dang et al with the teaching(s) from Sako, motivation is to provide for a specific location of the copy protect

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to perform the inherent control designation. Since there is no indication in either of these references that the disk is contained in a cartridge, the examiner concludes that the disk is not in cartridge and hence meets the limitations of claim 8.

15. Claims 1, 2 and 8 are rejected under 35 U.S.C. 102(e)/103 (c) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ludtke et al.

Applicants' attention is drawn to figures one through 12 in the above the Ludtke et al reference. As disclosed in this document, the ability of having a particular write protect designation/attribute bit is found. As far as the examiner can interpret from this document these fields, tables, are normally found in the data management area of the disk. If applicants' can convince the examiner that such tables are not found in the data management area of the disk, then the examiner would rely upon the above reference to Sako who teaches such an ability to present a rejection under 103. Motivation to combine would be to take advantage of a centralized to data management area on the disk. With respect to claim 8 since Ludtke et al disclose the use of such tables/format for DVDs this limitation is met. Again the disks referred to in the Ludtke et al reference are not contained in a cartridge, and hence the limitation of claim 8 is met.

16. Claims 3,5,6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 has stated above in paragraph 15, and further in view of the acknowledged Prior Art.

The limitations of claims 3, 5 and 6 are considered to be part of the acknowledged Prior Art as disclosed by applicants.

It would have been obvious to one of ordinary skill in the art to modify the base references of Ludtke et al/Sako with the teaching(s) from acknowledged Prior Art, motivation is to take advantage of existing formats available to those of ordinary skill in the art in this environment and hence provide for compatibility with those formats.

With respect to claim 7, since Ludtke in figure 10 designates a specific attribute bit/byte the selection of the designated/claimed byte position is considered merely a selection of the equivalent capabilities, and the selection of one position over another is merely a selection of equivalents with no unexpected results occurring from such a selection.

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16. Claims 1, 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ozaki et al.

Applicants' attention is drawn to the attribute information disclosed in this document which refers to the ability of not providing for an overwrite to those designated areas, see for instance col. 6, lines 6 - 11. The examiner interprets that these attributes are found in the program management/table of contents area normally found in this environment. Applicants' attention is also drawn to figures 10 through 13 and their associated disclosure.

17. Claims 2, 3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki et al as applied to claims 1 and 8 above, and further in view of the acknowledged Prior Art.

With respect to claims 2, 3, 5 and 6, applicants' have acknowledged the limitations as being part of the acknowledged Prior Art. The Ozaki et al reference focuses on the CD environment.

The acknowledged Prior Art focuses on the DVD environment.

It would have been obvious to one of ordinary skill in the art to modify the base reference of Ozaki et al with the teaching(s) from the acknowledged Prior Art, motivation is to increase the useful function of the right protect/prevent capability from the CD environment into the being the al more popular DVD environment.

18. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki et al as applied to claims 1 and 8 above, and further in view of either Ludtke et al or McFerrin et al.

With respect to the limitations of claim 7, either of the above noted secondary references teach the ability of placing the control signal/designation, in a particular position (byte/bit). The selection of a specific byte position is considered merely a design expediency and obvious to one of ordinary skill in the art. The selection of one byte position over another is considered a selection of equivalents and hence obvious especially since no unexpected results are seen to occur from such a selection.

### **Conclusion**

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Oshima et al, see col. 3 line 14 plus with respect to a cipher to prevent unwanted overwriting or erasing. Miwa et al – see the description in column 1, line 55 plus with respect to the ability of providing for copy protection/copy management in the table of contents area for DVDs. Furthermore this document

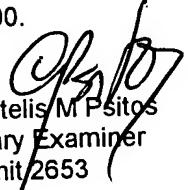
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commencing at column 2, line 59 through column 3 line 19 which refers to the ability with respect to erasing procedure. Ito et al, which further designates the standard disk, formats in this environment see for instance figure 1 and the use thereof with the appropriate reading ability.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

  
Aristotelis M Psitos  
Primary Examiner  
Art Unit 2653

AMP  
March 12, 2002